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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/645,318 | 08/25/2000 | YUJI KONNO | 862.C1986 | 3253 |
| 5514 | 7590 | 10/06/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | LETT, THOMAS J | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2626 | | |
| DATE MAILED: 10/06/2004 | | | | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/645,318 | KONNO ET AL. |
| | Examiner Thomas J. Lett | Art Unit 2626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 August 2000.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3,5,8-10,12 and 15 is/are rejected.
 7) Claim(s) 4,6,7,11,13, and 14 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 25 August 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4 and 7</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the numbering of the printer is inconsistent. The printer element should be labeled "104" (p8, line 13).

Appropriate correction is required.

2. The disclosure is objected to because of the following informalities: the numbering of the data compression unit is inconsistent. The data compression unit element should be labeled "202" (p11, line 15).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 recites the limitation " predetermined data unit " in line 16. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 9 recites the limitation " predetermined data unit " in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3, 5, 8-10, 12, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsukagoshi (US Patent 5,684,542 A).

Tsukagoshi discloses a quantization circuit 70 that processes color values and sends the values to a DPCM 75 to be quantized and converted, by encoding, to a digital signal (col 9, lines 46-50), which reads on a quantization means for quantizing multi-valued image data into N-valued data (where N is a natural number), and outputting the N-valued data as a K-bit code (where K is a natural number) that can express N values;

the run length coding circuit 66 encodes the input DPCM subtitle data into a data pair of level data and run data. (col 9, lines 50-52), which reads on a conversion means for combining and converting K-bit codes for M pixels (where M is a natural number) into an L-bit code (where L < M x K); and

the output of the run length coding circuit 66 is data of 1, 3, 3, 5, 5, 5, . . . for example, combined output data of separate sets of four-bit data of the packing circuit 68 (col 9, lines 58-62), which reads on an output means for packing and outputting data output from said conversion means into data of a predetermined bit unit.

With respect to claim 2 as best understood by Examiner, Tsukagoshi discloses the output of the packing circuit 68 as combined code of 4 bits representing a one-digit number (col 9, lines 57-62) and this date is transferred to a video camera or a disk 91 or a channel (see Fig. 1), which reads on the predetermined bit unit is a natural number multiple of the L bits, and data of the predetermined data unit is transferred to an image forming apparatus.

With respect to claim 3, Tsukagoshi discloses that the packing circuit computes a generated amount of the subtitle data at constant intervals and supplies its computed result to the rate controller 52a of the video encoding unit 52. Since the rate controller 52a can recognize a bit amount of the first pass of the video coding in the processing of the first pass and when it can recognize the data amount of the subtitle data from the signal from the packing circuit, it sets a bit rate in the video encoding unit so that it becomes a variable rate fully utilizing the capacity of the channel or the recording medium such as the disk 91 (col 10, lines 22-30), which reads on a control means for computing a memory size that the image forming apparatus requires for a process, and controlling said conversion means in accordance.

With respect to claim 5, Tsukagoshi discloses a color quantization circuit 70 which quantizes based on input R,G,B color data (see Fig. 1) and coding circuits 66 and

67 that encode the color subtitle data, which reads on quantization means and said conversion means execute processes according to components of the image data.

Claim 8 is a method claim and is rejected for the same reasons as that of claim 1.

Claim 9 is a method claim and is rejected for the same reasons as that of claim 2.

Claim 10 is a method claim and is rejected for the same reasons as that of claim 3.

Claim 12 is a method claim and is rejected for the same reasons as that of claim 5.

Claim 15 is a computer program product claim and is rejected for the same reasons as that of claim 1.

Allowable Subject Matter

6. Claims 4,6,7,11,13, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA Sixth Floor (Receptionist).

TJL

KWilliams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER